

## **REMARKS**

In the Final Office Action to the Parent Application, Paper Number 5, the Examiner rejected several claims under 35 U.S.C. § 102(a) as unpatentable over the prior art. The Examiner allowed two claims in the Parent Application and objected to several other claims. Applicants filed a Response to the Final Office Action canceling the rejected claims, without prejudice, in favor of a Continuation Application, and added new claims re-presenting the dependent claims to which the Examiner objected, thereby placing the Parent Application in condition for allowance. The Parent Application was pending at the time of the filing of this Continuation Application.

This Preliminary Amendment addresses the Examiner's rejections of claims in the Parent Application. In the Final Office Action for the parent application, the Examiner rejected Claims 1, 3-7, 9, 11-18, 21, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Augustine (5,674,269) ("the '269 patent") in view of Augustine (6,102,936) ("the '936 patent"). The Examiner rejected claims 8, 19, and 27 under 35 U.S.C. § 103(a) as being unpatentable over the '269 patent and the '936 patent in view of Namenyé, et al. (5,443,488) ("the '488 patent"). The Examiner rejected Claims 22-24 under 35 U.S.C. § 103(a) as being unpatentable over Berke (5,165,400) ("the '400 patent") in view of the '936 patent and in further view of the '269 patent.

Claims 3, 4, 5, 7, 15, 17, 18, and 24 of the Continuation Application are cancelled, without prejudice. Claims 28 to 35 are new claims, which are supported by the written description of the Parent Application. Claims 6, 12, 13, 16, and 21 are presented as originally in the Parent Application. Claims 1, 8, 9, 11, 14, 19, 22, 23, and 26 have been amended.

The Parent Application included Claims 2, 10, 20, and 25, which were objected to by the Examiner. These claims have been intentionally omitted from the Continuation Application, although their numbers are reserved to preserve the numbering of the other claims from the Parent Application. Additionally, the Parent Application included Claims 28 to 33, which were allowed by the Examiner. These claims are not shown in the Continuation Application. Finally, Claim 27 from the Parent Application has been intentionally omitted from the Continuation Application. Claim 27 of the Parent Application has been cancelled, without prejudice, and remains

cancelled, without prejudice, although the number is shown above to preserve the numbering from the Parent Application.

Claims 1, 6, 8, 9, 11, 12, 13, 14, 16, 19, 21, 22, 23, 26, and 28 to 35 are currently pending in this Application. Applicants respectfully submit that these claims are in condition for allowance.

### **Obviousness Under 35 U.S.C. § 103**

A rejection under 35 U.S.C. § 103(a) must be supported by a prima facie case of obviousness. MPEP § 2142. "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP § 2142, pg. 2100-121.

The first element in establishing a prima facie case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." MPEP § 2143. The second element is that there must be a reasonable expectation of success. *Id.* The third element is that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." *Id.* "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper); see MPEP § 2143.01.

### **Claim Amendments**

Claim 1 has been amended to replace "a plurality of exhaust ports" with "a means for exhausting air." Additionally, Claim 1 has been amended to include the limitation that "said first leg, said second leg, and said crosspiece defining a U-shaped opening sized to accommodate a head of the patient between said first leg and said second leg, and said first leg and said second leg having a length sufficient to extend

from a shoulder of the patient to a crown of said head of the patient." This limitation was originally included in dependent Claim 3, which has been cancelled, without prejudice. Finally, Claim 1 has been amended to remove the term "whereby" and change the verb tense of the term "hold." These changes were made to make the phrase grammatically correct and to ensure that the Applicant's original intent that the limitation following the whereby term be interpreted as a limitation. See MPEP 2106, pg. 2100-8, 8th ed. Rev. 1.

Claim 14 has been amended to include the limitation that "said U-shaped opening sized to accommodate a head of the patient between said first leg and said second leg." This limitation is one included in original Claim 15, now cancelled, without prejudice.

Claim 22 has been amended to include the limitation of "attaching at least one securing tab from said first leg to said base sheet," which is similar to the limitation included in Claim 2. Applicants respectfully submit that Claim 22 is allowable because Claim 22 includes similar structural limitations as contained in Claim 2, which was rewritten as Claim 30, which the Examiner determined was allowable in the Parent Application.

Claim 26 has been amended to include the limitation of "said tube formed by overlaying a first tube sheet and a second tube sheet and joining said first tube sheet and said second tube sheet at a common outside edge, said tube having a first leg, a second leg, and a crosspiece defining a U-shaped opening, said U-shaped opening sized to accommodate a head of the patient between said first leg and said second leg." With such amendment, Applicants respectfully submit that Claim 26 is in condition for allowance.

#### **Means-plus-function claim**

Claim 21 includes means-plus-function limitations. A means-plus-function limitation must be interpreted to cover the corresponding structure, materials, or acts in the specification and "equivalents thereof." 35 U.S.C. § 112, sixth paragraph; see also MPEP § 2181. The Examiner "must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of

and consistent with the written description of the invention in the application." MPEP 2181, pg. 2100-209, 8th ed. (emphasis added).

In accordance with MPEP § 2181, it no longer is acceptable practice for the Examiner to interpret means-plus-function limitations "as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification." MPEP § 2181, pg. 2100-209 (emphasis added). "[T]he application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim." MPEP § 2182, pg. 2100-214. "However, if a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function." *Id.* (emphasis added).

### **Evidence of Non-Obviousness**

Neither the patents cited in the Final Office Action of the Parent Application nor any other evidence of record establish a prima facie case of obviousness for the claims of the Continuation Application. Filed herewith is a 37 C.F.R. § 1.132 Declaration of Kelley Patten, a person with experience in the field of heat therapy devices. The facts set forth in Kelley Patten's declaration establish the following:

1. The combination of references proposed in the Final Office Action would render the construction of the references inoperable for their intended purposes. *See* MPEP 2143.01, pg. 2100-127, and MPEP 2145 sec. III, pg. 2100-154 to 155 (8th ed. Rev. 1).
2. The combination of the references do not "teach or suggest all the claim limitations" as required by the third element of a prima facie case of obviousness. *See* MPEP 2143.

3. There was no motivation or suggestion in the art, as of the filing date of the parent application, that would have prompted one skilled in the art to make the combinations suggested by the Examiner.

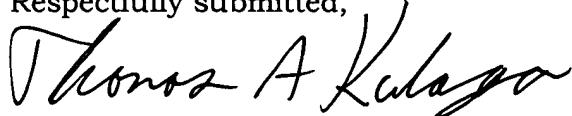
Applicants respectfully submit that the Examiner has not met his burden for rejecting the claims of the Parent Application. Accordingly, Applicants respectfully submit that the claims of the Continuation Application, which are similar to and based on the claims of the Parent Application, are allowable.

### **Conclusion**

It is believed that Claims 1, 6, 8, 9, 11, 12, 13, 14, 16, 19, 21, 22, 23, 26, and 28 to 35 of the above-identified Continuation Application are allowable and the Continuation Application is in a condition for the issuance of a Notice of Allowance. Such action by the Examiner is respectfully requested. If, however, the Examiner is of the opinion that any of the drawings or other portions of the application are still not allowable, it will be appreciated if the Examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 16-1910 (27230.03).

Respectfully submitted,



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